

Docket No. IRI05426

BEST AVAILABLE COPY**REMARKS**

Claims 1-5, 9-13 and 14-19 remain in the application. The actions taken are in the interest of expediting prosecution and with no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled in view of the prior art. Moreover, the amendment or cancellation of claims herein is without prejudice to pursuing claims of different scope by way of continuing Application. Reconsideration of this application is respectfully requested.

U.S.C. 103

Claims 1, 9 and 17 are rejected under U.S.C. §103 as being unpatentable over Bertrand et al. (U.S. Patent No. 6,687,2552, hereinafter Bertrand) in view of Vilander et al. (U.S. Patent No. 6,618,592, hereinafter Vilander). Claims 2-5, 10-13 and 18-19 are rejected under U.S.C. §103 as being unpatentable over Bertrand in view of Vilander in further view of DHCP for IPv6 (hereinafter DHCP).

It is incumbent upon the Examiner to prove a *prima facie* case of obviousness (MPEP 2142). To establish a *prima facie* case three basic criteria must be met. First, the prior art reference must teach or suggest all the claim limitations. Second, there must be a reasonable expectation of success. Finally, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference.

The Examiner has stated that Bertrand et al. FIG. 3. and col. 7, lines 27 to 45 disclose duplicate address detection being performed by the network and cite Bertrand et al. col. 6, line 63 to col. 7, line 4 as disclosing prefix transmission. However, the transmission of a unique IP address and a prefix identifying an external network from whom the IP address has been obtained from a network to a mobile station where the IP address has been determined to be unique by the network as claimed in amended Claims 1, 9 and 17 is neither disclosed nor taught nor disclosed in Bertrand et al. Specifically, a prefix identifying an external network being sent in addition to a unique IP address assigned by the external network is not taught by or suggested in Bertrand et al. This is acknowledged by the Examiner in the February 23, 2006 Office Action.

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Bertrand et al. discloses that "[i]t is preferable to provide an IP address to the [mobile station] with the same network prefix as the [mobile station's] home address." Col. 7, lns. 2 to 4. In other words, Bertrand et al. teaches away from transmitting a prefix to the mobile station identifying the external network.

The Examiner has attempted to make up for the deficiency in Bertrand through the teachings of Vilander. Vilander teaches a Radio Network Controller (RNC) of a mobile network repeatedly broadcasting a routing prefix over its cellular network so that the mobile can use the prefix to incorporate into an IP address (column 2, lines 36-44). The routing prefix broadcast is either unique to the RNC or to the mobile network (column 2 lines 50-52, and column 3 lines 60-65, column 4 lines 25-29) and not to the external network as recited by Applicants. The IP routing prefix broadcast is previously allocated to the RNC prior to broadcast. Therefore, this is not an address prefix of the external network, but merely a prefix assigned to the RNC before broadcasting. Further, Vilander teaches broadcasting the routing prefix continuously regardless of whether the mobile device has requested access to the external network via the mobile network.

The combination of Bertrand and Vilander is improper as they do not teach toward each other. Bertrand teaches providing an IP address to a mobile device, where the address prefix is the same as the mobile device's home address (Bertrand column 7 lines 2-4). As shown above, Bertrand teaches away from the recited claims. Vilander teaches continuously broadcasting a routing prefix specifically assigned to an RNC regardless of whether a request for such a prefix is made by the mobile. Vilander also teaches away from the recited claims. It would not be obvious to take the continuously broadcast prefix of Vilander and provide it to the mobile device taught by Bertrand, since in Bertrand the very problem solved (dynamically allocating IP addresses to mobile stations to prevent IP conflicts while providing addresses that are usable to a mobile station running a real-time application, Bertrand column 2 lines 10-17) requires the use of a prefix with the same network prefix as the mobile's home address, and not an address prefix of the external network as recited by Applicants.

Therefore, it is clear that there is no suggestion, either in the references or in the prior art, to combine the teachings of Bertrand with those of Vilander. Any combination is impermissible hindsight reconstruction based on Applicant's disclosure. Further, the teachings of the cited references, taken individually or together, do not contain each and every element of Applicant's

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recited claims. Accordingly, Applicants respectfully submit that independent Claims 1, 9 and 17 are non-obvious over the cited and that they proceed to allowance.

Dependent claims 2-5, 10-13 and 8-19 are believed allowable for the same reasons as independent claims 1, 9 and 17 above as DHCP does not make up for the deficiencies of Bertrand and Vilander.

Summary

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

The Applicants believe that the subject application, as amended, is in condition for allowance. Such action is earnestly solicited by the Applicants.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicant's attorney or agent at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection.

Accordingly, this application is believed to be in proper form for allowance and an early notice of allowance is respectfully requested.

Please charge any fees associated herewith, including extension of time fees, to 502117, Motorola, Inc.

Respectfully submitted,

DATE: 3-29-06
SEND CORRESPONDENCE TO:
Motorola, Inc.
Law Department
1303 East Algonquin Road
IL01/3rd
Schaumburg, Illinois 60196
Customer Number: 23330

By: Kevin D. Wills
Kevin D. Wills
Attorney of Record
Reg. No.: 43,993
Telephone: 480-732-5364
Fax No.: 480-732-2402
Email: Kevin.Wills@motorola.com